

REMARKS

This is a full and timely response to the non-final Office Action mailed June 16, 2004. Upon entry of the amendments in this response, claims 1 – 20 are pending. In particular, Applicant has amended claims 1 – 12 and has added claims 13-20. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. In the Specification

The Office Action alleges that the disclosure is objected to because of various informalities. Specifically, the Office Action indicates that “the section ‘CROSS-REFERENCE TO RELATED APPLICATIONS’ is missing the claimed priority information.” (Office Action, pg. 2). Additionally, the Office Action alleges that “the title of the invention is not descriptive.” (Office Action, pg. 2).

As set forth above, Applicant has amended the specification to include the priority information. Additionally, the title has been amended as suggested in the pending Office Action. Accordingly, the Applicant respectfully submits that the objections to the specification have been overcome and requests that the objections be withdrawn.

II. In the Drawings

The Office Action alleges that “Figures 1 – 3 should be designated by a legend such as -- Prior Art – because only that which is old is illustrated.” (Office Action, pg. 2). The Office Action further alleges that “E-mail index search graphical user interface and supporting search database components is well known in the prior art, for example,

Administrators using Microsoft Outlook 97, Schedule + program and supporting databases.” (Office Action, pgs. 2-3).

Applicant respectfully submits that Figures 1 – 3 do not illustrate prior art as alleged. As an initial matter, Figures 1 – 3 are not representations of the prior art, but rather represent embodiments of the claimed systems and methods.

For example, Applicant’s Description of the Drawings plainly recites that: “Figure 1 is a schematic diagram of the *preferred embodiment* of search facility,” (*Emphasis added*, pg. 4, line 5); “Figure 2 is a schematic diagram of the *preferred embodiment* of results display.” (*Emphasis added*, pg. 4, lines 7-8); and “Figure 3 is a schematic diagram of the *preferred embodiment* of electronic address creation system.” (*Emphasis added*, pg. 4, lines 10-11).

Applicant traverses the Office Action’s allegation that Figures 1 – 3 represent such prior art. Figure 1 depicts a search facility used in preferred embodiments of the invention. Applicant further submits that the standardized email format in Figure 2 depicting “alan.derek.dean.RM163JA.0@index.com,” and generated by Applicant’s system, is not known in the prior art. Similarly, Applicant submits that the depiction of interconnected components in Figure 3 are not known in the prior art. For example, Applicant is not aware of prior art references, including those cited in the present Office Action, that disclose an email address generator that uses a name code generator and a location code generator.

If the rejection is maintained in an ensuing Office Action, Applicant respectfully requests that the Office Action include specific supporting documentation as to the basis of the alleged prior art. Applicant further submits that requiring Figures 1-3, which

Applicant regards as representing embodiments of portions of the claimed systems and methods, to be labeled as “prior art” would essentially require the Applicant to declare that the entirety of Applicant’s systems and methods are unpatentable.

Accordingly, Applicants respectfully submit that Figures 1-3 do not represent only that which is known. Therefore, for at least these reasons, Applicants should not be required to label each of Figures 1-3 as “Prior Art.” Accordingly, no drawing amendments are believed to be necessary.

III. Claim Objections

The Office Action objects to claims 1-2, 4, and 10 as allegedly containing a number of informalities.

Claims 1 and 2

The Office Action indicates that claims 1 and 2 are objected to because they use the term “standardised,” rather than “standardized.” (Office Action, pg. 3). As set forth above, Applicant has amended claims 1 and 2 to correct this informality and respectfully asserts that the objection to claims 1 and 2 should be withdrawn.

Claims 4 and 10

The Office Action alleges that claims 4 and 10 incorrectly use the phrase “each individual in a country,” and suggests using the phrase “individual’s country” instead. (Office Action, pg. 3). Applicant appreciates the consideration given to this claim, but submits that the language in claims 4 and 10 are set forth as intended. Specifically, as set forth in the detailed description, “one or more structured addresses are created for each individual in a country, geographic region or state.” (pg. 2, lines 28-29). Applicant notes

that, typically, the physical address of each person in a country, geographic region, and/or state may be public information. Thus, without requiring any particular action by the individual, electronic mail addresses may be generated for each individual in that country, geographic region or state. Accordingly, no amendments to claims 4 and 10 are believed to be necessary, and Applicant respectfully requests that the objection to claims 4 and 10 be withdrawn.

IV. Claims 1 – 12 Comply with 35 U.S.C. §101

The Office Action rejects claims 1 – 12 as allegedly “software per se [sic] that is not tangibly embodied on a computer readable medium and therefore lacks a practical application because it alone cannot produce its intended outcome.” (Office Action, pg. 3).

It has long been recognized in patent law that “anything under the sun that is manmade” is statutory subject matter. *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 U.S.P.Q. 193, 197 (1980). Specifically, 35 U.S.C. § 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, articles of manufacture, and compositions of matter. Claims 1 through 6, as originally filed, defined one or more steps to be performed, and therefore, are statutory subject matter under the category of a process. Claims 7 through 12 define a system for generating a set of standardized electronic mail addresses. Both the system and the method produce a new and useful tangible result of at least a standardized electronic mail address, and therefore, is statutory subject matter under the category of a machine and a process, respectively.

Although Applicant believes that claims 1-12 as originally filed, do recite statutory subject matter, Applicant has amended claims 1-6 to be directed to a program storage device readable by a machine and encoding a program of instructions. Additionally, the system of claims 7-12 now includes “logic” which is configured to perform a particular function. Accordingly, Applicant respectfully submits that the 35 U.S.C. § 101 rejection of claims 1 – 12 is moot and should be withdrawn.

The amendments of claims 1 – 12 have been made merely to expedite prosecution of the present application and early allowance of the claims. Applicant believes that no substantive limitations have been added to the claims by these amendments and therefore no prosecution history estoppel arises from these amendments. *Black & Decker, Inc. v. Hoover Service Center*, 886 F.2d 1285, 1294 n. 13 (Fed. Cir. 1989); *Andres Corp. v. Gabriel Electronics, Inc.*, 847 F.2d 819 (Fed. Cir. 1988); *Hi-Life Products, Inc. v. American National Water-Mattress Corp.*, 842 F.2d 323, 325 (Fed. Cir. 1988); *Mannesmann Demag Corp. v. Engineered Metal Products Co., Inc.*, 793 F.2d 1279, 1284-1285 (Fed. Cir. 1986); *Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986).

V. Claim 3 Complies with 35 U.S.C. §112, Second Paragraph

The Office Action rejects claim 3 under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Specifically, the Office Action alleges that the phrase “preferably” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

Applicants have removed the term “preferably” from claim 3. Accordingly, Applicants submit that the rejection of claim 3 under §112 has been addressed and should be withdrawn.

VI. Claims 1 - 12 are Patentable Over *Wu*

The Office Action rejects claims 1 - 12 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,125,369 to Wu (“*Wu*”). For at least the reasons set forth below, the rejection should be withdrawn and the claims allowed.

Independent Claim 1

The Applicants respectfully submit that claim 1 patentably defines over *Wu* for at least the reason that *Wu* fails to disclose or otherwise teach “***generating an electronic mail address for said person based on said personal name code and said location code***” as recited in claim 1.

Unlike the device for generating a set of standardized electronic mail addresses of claim 1, *Wu* does not appear to disclose generating email addresses at all. Further, Applicant has reviewed the entirety of *Wu*, including the portions highlighted in the Office Action, and has performed a computer-based textual search of *Wu* for the terms “email,” “e-mail,” “mail,” “electronic mail,” and “address” and have not discovered any disclosure related to “an electronic mail address” or “generating an electronic mail address” as recited in claim 1. Rather, *Wu* is apparently directed to synchronizing object stores, such as databases, on different computers that are only occasionally connected for data communications computers. (Col. 1, lines 13-15).

Accordingly, claim 1 should be allowed for at least the reason that *Wu* fails to disclose or otherwise teach “***generating an electronic mail address for said person based on said personal name code and said location code***” as recited in claim 1. Furthermore, because independent claim 1 is allowable over *Wu*, dependent claims 2 – 6 are allowable as a matter of law for at least the reason they contain all the features and elements of independent claim 1, from which they depend.

Independent Claim 7

The Applicants respectfully submit that claim 7 patently defines over *Wu* for at least the reason that *Wu* fails to disclose or otherwise teach “***logic configured to generate an electronic mail address for said person based on said personal name code and said location code***” as recited in claim 7.

Unlike the system for generating a set of standardized electronic mail addresses of claim 7, *Wu* does not appear to disclose generating email addresses at all. Further, Applicant has reviewed the entirety of *Wu*, including the portions highlighted in the Office Action, and has performed a computer-based textual search for the terms “email,” “e-mail,” “mail,” “electronic mail,” and “address” and have not discovered any disclosure related to “an electronic mail address” or “logic configured to generate an electronic mail address” as recited in claim 7. Rather, *Wu* is apparently directed to synchronizing object stores, such as databases, on different computers that are only occasionally connected for data communications. (Col. 1, lines 13-15).

Accordingly, claim 7 should be allowed for at least the reason that *Wu* fails to disclose or otherwise teach “***generating an electronic mail address for said person based on said personal name code and said location code***” as recited in claim 7. Furthermore,

because independent claim 7 is allowable over *Wu*, dependent claims 8 - 12 are allowable as a matter of law for at least the reason they contain all the features and elements of independent claim 7, from which they depend.

Dependent Claims 2-6 and 8-12

Applicants submit that the rejection to dependent claims 2-6 and 8-12 is rendered moot in light of any of the arguments made above and, therefore, claims 2-6 and 8-12 are allowable as a matter of law for at least the reason that claims 2-6 and 8-12 contain all features and elements of their corresponding independent claim. For at least this reason, Applicants request that the rejection of claims 2-6 and 8-12 be withdrawn.

VII. Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

The Applicant respectfully submits that all claims are now in condition for allowance, and request that the Examiner pass this case to issuance. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

No fee is believed to be due in connection with this response. If, however, any fee is deemed to be payable, you are hereby authorized to charge any such fee to Deposit Account No. 20-0778.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Scott Horstemeyer", written over a horizontal line.

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